

Claims 2 and 4 stand finally rejected under 35 USC 112, second paragraph.

WIP

Claim 2 stands rejected in that the meaning of the term 'integral' with surrounding regions is unclear.

Applicant clearly defines the meaning of this term at lines 6-20 on page 3 of the specification, where it is stated:

'... the markings 4, 5 are formed in that visual properties - in this example shade of darkness and color - of regions 9 of the outer layer 3 exhibit a clearly visible difference from the corresponding visual properties of the other regions of the outer layer 3. In this example, the outer layer has a yellow ochre color, whereas the markings are of a darker color and more brownish. **Since the markings form part of the outer layer 3**, their presence has no substantial negative effect on the sliding properties of the outer layer, the protective effect of the outer layer 3, and the dust-repellent properties of the outer layer 3.
... it is further achieved thereby that the **markings 4, 5 are formed integrally with other portions of the outer layer 3** ... (emphasis added).'

It is clear from this description that the regions 9, which includes the markings, form a part of the outer layer 3 and are therefore integral with the outer layer 3, as shown in Fig.

4.

Moreover, Applicant's use of the term 'integral' is entirely consistent with the accepted meaning of the term according to Webster's Dictionary, which defines 'integral' *inter alia* as composed of constituent parts making a whole, as an integral whole.

In claim 4, the term 'dull-translucent' is said to be a relative term which renders the claim indefinite. Claim 4 has been cancelled. However, the term 'dull-translucent' has been inserted into claim 1.

This term is used to describe a condition of the surface of the outer layer which enhances the contrast between the markings and the surrounding regions. In this context, the term would be readily understood by the skilled artisan to refer to a surface having a low reflectivity, thereby enhancing the visibility of the markings surrounded by such a surface.

Again, this usage is consistent with the commonly accepted meanings of the terms 'dull' and 'translucent' as defined by Webster's Dictionary. Therein, 'dull' is defined *inter alia* as lacking brilliance of light, as a dull fire; lacking luster, as a dull mirror; of low saturation and low brilliance, as a dull green. 'Translucent' is defined *inter alia* as admitting passage of light but diffusing it so that objects beyond cannot be clearly distinguished; partly transparent.

It is urged that the meaning of the term 'dull-translucent' is clear and definite both from its use to define a surface condition which enhances visibility of the markings and from the commonly understood meanings of the words 'dull' and 'translucent'. The skilled artisan would have no difficulty in distinguishing such a surface from a 'highly reflective' surface, for example, as called for by Robertson U.S. patent 5,855,969 (col. 5, line 30).

WJD

In view of the above arguments and amendments, it is urged that the rejection under 35 USC 112, second paragraph, is in error and should be withdrawn.

Claims 1-4, 6, 7, 9, 10 and 12 stand finally rejected under 35 USC 102 and/or 103(a) over Birmingham Jr. et al. U.S. patent 5,789,466 (hereinafter 'Birmingham').

In response to Applicant's argument that Birmingham fails to teach an outer layer comprising a polymer material with an inorganic main chain, the Examiner urges that Birmingham teaches that the main chain may be organic or inorganic, citing col. 5, lines 21-39.

Birmingham states that polysiloxane may be used in the invention, with the radical group R of such polysiloxane being either organic or inorganic. See col. 5, lines 21-26. However, the polysiloxane is not used in the formation of the substrate, ^{WJD, Cm²} but rather is used in a mixture with organo silane to coat TiO₂ pigment particles. See for example col. 2, lines 23-24 and col. 4, lines 16-19. There is no teaching or suggestion of an outer layer or substrate comprising a polymer material with an inorganic main chain.

Since Birmingham does not teach or suggest an outer layer or substrate comprising a polymer material with an inorganic main chain, Birmingham neither anticipates nor renders obvious claim 1. Thus, claim 1 is patentable over Birmingham. ^{WJD, Cm²}

Without conceding the patentability per se of the remaining rejected claims, these claims are urged to be patentable by virtue of their direct or indirect dependence on claim 1.

Accordingly, the rejection over Birmingham is in error and should be withdrawn.

Claims 1-6, 8 and 12 stand finally rejected under 35 USC 102 and/or 103(a) over Robertson U.S. patent 5,855,969.

Robertson teaches a method for the laser marking of a coated surface. Robertson does not explain how the coated surface is obtained. Moreover, Robertson teaches that the surface should be highly reflective (col. 5, line 30). *To read type* *only was part* *not limited to all* *colors*

In contrast, Applicant teaches that the outer surface is a dull-translucent surface. (See page 4, lines 29-33 of the specification). Accordingly, the limitation of claim 4 that the outer surface is a dull-translucent surface has been inserted into claim 1 and claim 4 has been cancelled.

Since Robertson does not teach or suggest a dull-translucent surface, but on the contrary, teaches a highly reflective surface, Robertson neither anticipates nor renders obvious claim 1. Thus, claim 1 is patentable over Robertson.

Without conceding the patentability per se of the remaining rejected claims, these claims are urged to be patentable by virtue of their direct or indirect dependence on claim 1.

Accordingly, the rejection of claims 1-6, 8 and 12 over Robertson is in error and should be withdrawn.

Claims 13 and 24 stand finally rejected under 35 USC 103(a) over Robertson. Without conceding patentability per se of claims 13 and 24, it is urged that these claims are patentable by virtue of their dependency. Accordingly, the rejections are in error and should be withdrawn.

In view of the above arguments and amendments, it is felt that the present application is in condition for allowance, and a Notice of Allowance is respectfully requested.

Respectfully submitted,

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APPENDIX

1. (Twice amended) An element for a consumer product, the element comprising a carrier and an outer layer, the outer layer formed by a sol-gel process and comprising a polymer material with an inorganic main chain, wherein at least a region of said outer layer has a visual appearance different from the visual appearance of surrounding regions of said outer layer, wherein the visual appearance of the surrounding regions of the outer layer is dull-translucent, wherein the at least a region forms a marking which is visible to the human eye.

13. (Twice Amended) An element as claimed in claim 24 15, wherein the hard material is selected from metal and metal alloy, and the carrier further comprising an anodized layer which supports said outer layer.